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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,988

10/05/2005

Gerhard Hamprecht

3165-137

6444

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7590

03/14/2008

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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WASHINGTON, DC 20005

EXAMINER

MABRY, JOHN

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

03/14/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No. 10/551,988	Applicant(s) HAMPRECHT ET AL.	
	Examiner John Mabry, PhD	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 16-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant(s) is required to amend claims with respect to restricted group.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 16-19, 22-23 and 28-39 are drawn to compounds and compositions of Formula I, wherein X₁=H, halogen, X=Cl, X₃=H, C₁-C₆ alkyl, A=O, B=O, S, Y=-CO₂R₁, -COSR₁, -SO₂NR₁R₂, -CONR₁R₂ where in R₂=H, alkyl, R₁ and R₂ cannot combine to form any cycle and Q=1,3,4-triazolyl of Formula Q₅ wherein R₆ and R₇=H, alkyl, haloalkyl and Q=1,2,4-triazolyl of Formula Q₇ wherein R₄₆ and R₄₇=H, alkyl and R₄₆/R₄₇ cannot combine to form 6-membered ring with O. A further election of single disclosed species is required.
- II. Claims 16-19, 22-23 and 28-39 are drawn to compounds and compositions of Formula I, wherein X₁=H, halogen, X=Cl, X₃=H, C₁-C₆ alkyl, A=O, B=O, S, Y=-CO₂R₁, -COSR₁, -SO₂NR₁R₂, -CONR₁R₂ where in R₂=H, alkyl, R₁ and R₂ cannot combine to form any cycle and Q=1,2,4-triazolyl for Formula Q₇ wherein

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R46 and R47 combine to form 6-membered ring with O. A further election of single disclosed species is required.

- III. Claims 16-19, 22-23 and 28-39 are drawn to compounds and compositions of Formula I, wherein $X_1=H$, halogen, $X=Cl$, $X_3=H$, C1-C6 alkyl, $A=O$, $B=O$, S, $Y=-CO_2R_1$, $-COSR_1$, $-SO_2NR_1R_2$, $-CONR_1R_2$ where in $R_2=H$, alkyl, R_1 and R_2 cannot combine to form any cycle and $Q=1,3$ -pyrimidinonyl for Formula Q21 wherein R_{30} and $R_{31}=H$, alkyl, haloalkyl and $Q=1,2$ -pyrimidinonyl for Formula Q27 wherein R_{34} , R_{35} and $R_{36}=H$, alkyl, haloalkyl. A further election of single disclosed species is required.
- IV. Claims 16-19, 22-23 and 28-39 are drawn to compounds and compositions of Formula I, wherein $X_1=H$, halogen, $X=Cl$, $X_3=H$, C1-C6 alkyl, $A=O$, $B=O$, S, $Y=-CO_2R_1$, $-COSR_1$, $-SO_2NR_1R_2$, $-CONR_1R_2$ where in $R_2=H$, alkyl, R_1 and R_2 cannot combine to form any cycle and $Q=1,3,5$ -triazinonyl for Formula Q22 wherein R_{32} and $R_{33}=H$, alkyl and $Q=1,3,4$ -triazinonyl for Formula Q39 wherein R_{44} and $R_{45}=H$, alkyl. A further election of single disclosed species is required.
- V. Claims 16-19, 22-23 and 28-39 are drawn to compounds and compositions of Formula I, wherein $X_1=H$, halogen, $X=Cl$, $X_3=H$, C1-C6 alkyl, $A=O$, $B=O$, S, $Y=-CO_2R_1$, $-COSR_1$, $-SO_2NR_1R_2$, $-CONR_1R_2$ where in $R_2=H$, alkyl, R_1 and R_2 cannot combine to form any cycle and $Q=1,2$ -pyrrolozolinyl for Formula Q32

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wherein R37, R38 and R39=H, alkyl, haloalkyl, alkoxy which can be substituted with halogen. A further election of single disclosed species is required.

- VI. Claims 16-19, 22-23 and 28-39 are drawn to compounds and compositions of Formula I, wherein X1=H, halogen, X=Cl, X3=H, C1-C6 alkyl, A=O, B=O, S, Y=-CO2R1, -COSR1, -SO2NR1R2, -CONR1R2 where in R2=H, alkyl, R1 and R2 cannot combine to form any cycle and Q=pyridinyl for Formula Q38 wherein R40-R43=H, alkyl, haloalkyl. A further election of single disclosed species is required.
- VII. Claims 16-19, 22-23 and 28-39 are drawn to compounds and compositions of Formula I that are not encompassed by Groups I- VIII. A further election of single disclosed species is required. This group may be subject to further restriction.
- VIII. Claim 21 is drawn to compounds and compositions of Formula II. A further election of single disclosed species is required. This group may be subject to further restriction.
- IX. Claim 20 is drawn to a process of preparing compounds of Formula II. A further election of single disclosed species is required. This group may be subject to further restriction.

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- X. Claims 24-25 are drawn to a process of preparing herbicidally effective compositions of Formula I selected from one of Groups I-IX. A further election of single disclosed species is required.
- XI. Claims 26-27 are drawn to a method of controlling unwanted vegetation and a method for the desiccation and/or defoliation using one of groups I-IX of Formula I. An election of species is required if this group is chosen.

The inventions listed as Groups I-XVI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features...those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The special technical feature corresponding to Group I is a compounds and compositions of Formula I, wherein $X_1=H$, halogen, $X=Cl$, $X_3=H$, C_1-C_6 alkyl, $A=O$, $B=O$, S , $Y=-CO_2R_1$, $-COSR_1$, $-SO_2NR_1R_2$, $-CONR_1R_2$ where in $R_2=H$, alkyl, R_1 and R_2 cannot combine to form any cycle and $Q=1,3,4$ -triazolyl of Formula Q5 wherein R_6 and $R_7=H$, alkyl, haloalkyl and $Q=1,2,4$ -triazolyl of Formula Q7 wherein R_{46} and $R_{47}=H$, alkyl and R_{46}/R_{47} cannot combine to form 6-membered ring with O.

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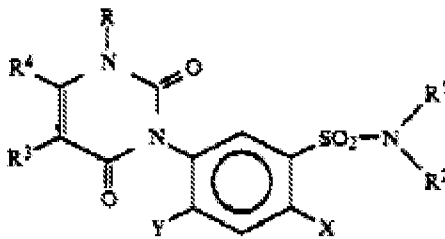
Group II contains a 1,2,4-triazolyl structure as its special technical feature, wherein $X_1=H$, halogen, $X=Cl$, $X_3=H$, C1-C6 alkyl, $A=O$, $B=O$, S, $Y=-CO_2R_1$, $-COSR_1$, $-SO_2NR_1R_2$, $-CONR_1R_2$ where in $R_2=H$, alkyl, R_1 and R_2 cannot combine to form any cycle and $Q=1,2,4$ -triazolyl for Formula Q7 wherein R_{46} and R_{47} combine to form 6-membered ring with O. Group III contains a 1,2-pyrimidinonyl and 1,3-pyrimidinonyl structure as its special technical feature, wherein $X_1=H$, halogen, $X=Cl$, $X_3=H$, C1-C6 alkyl, $A=O$, $B=O$, S, $Y=-CO_2R_1$, $-COSR_1$, $-SO_2NR_1R_2$, $-CONR_1R_2$ where in $R_2=H$, alkyl, R_1 and R_2 cannot combine to form any cycle and $Q=1,3$ -pyrimidinonyl for Formula Q21 wherein R_{30} and $R_{31}=H$, alkyl, haloalkyl and $Q=1,2$ -pyrimidinonyl for Formula Q27 wherein R_{34} , R_{35} and $R_{36}=H$, alkyl, haloalkyl. Group IV contains a 1,3,4-triazinonyl and 1,3,5-triazinonyl structure as its special technical feature, wherein $X_1=H$, halogen, $X=Cl$, $X_3=H$, C1-C6 alkyl, $A=O$, $B=O$, S, $Y=-CO_2R_1$, $-COSR_1$, $-SO_2NR_1R_2$, $-CONR_1R_2$ where in $R_2=H$, alkyl, R_1 and R_2 cannot combine to form any cycle and $Q=1,3,5$ -triazinonyl for Formula Q22 wherein R_{32} and $R_{33}=H$, alkyl and $Q=1,3,4$ -triazinonyl for Formula Q39 wherein R_{44} and $R_{45}=H$, alkyl. Group V contains a 1,2-pyrrolozolinyl structure as its special technical feature, wherein $X_1=H$, halogen, $X=Cl$, $X_3=H$, C1-C6 alkyl, $A=O$, $B=O$, S, $Y=-CO_2R_1$, $-COSR_1$, $-SO_2NR_1R_2$, $-CONR_1R_2$ where in $R_2=H$, alkyl, R_1 and R_2 cannot combine to form any cycle and $Q=1,2$ -pyrrolozolinyl for Formula Q32 wherein R_{37} , R_{38} and $R_{39}=H$, alkyl, haloalkyl, alkoxy which can be substituted with halogen. Group VI contains a pyridinyl structure as its special technical feature, wherein $X_1=H$, halogen, $X=Cl$, $X_3=H$, C1-C6 alkyl, $A=O$, $B=O$, S, $Y=-CO_2R_1$, $-COSR_1$, $-SO_2NR_1R_2$, $-CONR_1R_2$ where in $R_2=H$, alkyl, R_1 and R_2

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cannot combine to form any cycle and Q=pyridinyl for Formula Q38 wherein R40-R43=H, alkyl, haloalkyl. Group VII contains compounds and compositions of Formula I that are not encompassed by Groups I- VIII as its special technical feature. Group X contains compounds and compositions of Formula II as its special technical feature. The ring systems are not considered equivalent.

The technical feature corresponding to the methods claims of Group XI is a method of controlling unwanted vegetation and a method for the desiccation and/or defoliation limited to the scope of one of groups I- I-IX of Formula I. There is a significant difference in the between compounds/composition and methods of treating as described by Applicant. These treatments and compounds/compositions are not considered equivalent.

The special technical feature of this invention is the common core found in Formula I. This special technical feature, found in US 5,169,430 (listed in IDS) A as described by Strunk et al (compounds 1-85, Table 1). Strunk et al also discloses a method of controlling unwanted vegetation, compounds of Formula II and a method of making compounds of Formula I (see entire disclosure).



Therefore the above claims, are not so linked as to form a single general inventive concept and there is a lack of unity of invention because they lack a common core structure and the technical features present fail to define a contribution over the prior art. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Therefore, since the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical features, the claims lack unity of invention and should be limited to only one invention.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable

over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Rejoinder Advisory

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise

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require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Applicant(s) is required to amend claims with respect to restricted group.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, PhD, can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/John Mabry, PhD/
Examiner
Art Unit 1625

/Rita J. Desai/
Primary Examiner, Art Unit 1625